

REMARKS

I. Introduction

With the addition of new claim 14, claims 1 to 3, 7, 11 and 14 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received in the parent application, i.e., U.S. Patent Application Serial No. 09/627,992.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

II. Double Patenting Rejection

Claims 1, 3 and 11 were rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 and 2 of U.S. Patent No. 6,666,311. The Office Action indicates that a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome this rejection. Without necessarily agreeing with the merits of this rejection, Applicant is prepared to submit a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) to overcome this rejection upon withdrawal of all other rejections and when the claims are otherwise indicated to be in final form for allowance.

III. Rejection of Claims 1, 2 and 11 Under 35 U.S.C. § 102(b)

Claims 1, 2 and 11 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 4,465,296 ("Shiratori et al."). Applicant respectfully submits that Shiratori et al. do not anticipate the present claims as amended herein for the following reasons.

Claim 1 relates to a spring strut support bearing. Claim 1 recites that the spring strut support bearing includes a top bearing having an inner ring by way of which the top bearing can be affixed to the end of a piston rod of a shock absorber connected to a vehicle body, an outer ring surrounding the inner ring with radial clearance defining a gap therebetween, the outer ring being stationary with

respect to the vehicle body, and at least one elastic spring element made of rubber-elastic material located in the gap formed by the clearance. Claim 1 further recites that the inner ring has two end faces, on each of which has at least one elastically flexible stop buffer for limiting extreme deflection movements along a deflection direction defined by the motion of a shock absorber, each of the stop buffers having the capability of being brought into contact with counter stop faces. Claim 1 has been amended herein without prejudice to recite that the elastically flexible stop buffer is annular. Support for the amendment to claim 1 may be found, for example, in Figure 1.

Shiratori et al. purport to relate to an upper support in vehicle suspension systems. The Office Action contends that elements 62, 64 constitute elastic flexible stop buffers. However, Shiratori et al. state that the projections or bosses 62, 64 are equally spaced at an angular interval of 120° and that air vent passageways 66, 68 are arranged between the bosses 62, 64 to permit the annular grooves 52, 54 to communicate with the outside atmosphere. Col. 4, lines 38 to 54. Thus, Shiratori et al. fail to disclose, or even suggest, an annular stop buffer, as recited in amended claim 1.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Shiratori et al. do not disclose, or even suggest, an annular stop buffer as recited in amended claim 1. It is therefore respectfully submitted that Shiratori does not anticipate amended claim 1.

As for claims 2 and 11, which depend from claim 1 and therefore include all of the limitations of claim 1, it is respectfully submitted that Shiratori et al. do not anticipate these dependent claims for at least the same reasons set forth above in support of the patentability of claim 1.

IV. Rejection of Claim 3 Under 35 U.S.C. § 103(a)

Claim 3 was rejected under 35 U.S.C. § 103(a) as unpatentable over Shiratori et al. Applicant respectfully submits that Shiratori et al. do not render unpatentable claim 3 for the following reasons.

Applicant first notes that the Office Action admits that Shiratori et al. do not disclose that stop buffers are produced separately and connected frictionally and/or with form locking to a respective end face of an inner ring. Applicant does not necessarily agree with the remaining contentions contained in paragraph 6 of the Office Action and provides the following remarks with respect to the present rejection.

Claim 3 depends from claim 1. As more fully set forth above, claim 1 has been amended herein without prejudice to recite that the at least one stop buffer is annular, and Shiratori et al. do not disclose, or even suggest, an annular stop buffer. Since Shiratori et al. describe air vent passageways 66, 68 arranged between bosses 62, 64 to permit communication between the annular grooves 52, 54 and the outside atmosphere, it is respectfully submitted that there is no motivation or suggestion to modify the device described by Shiratori et al. to include an annular stop buffer. This is because doing so would render the device described by Shiratori et al. unsatisfactory for its intended purpose and/or change the principle of operation thereof. See, In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (if a proposed modification would render the device described in a relied upon reference that is being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification); In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959) (if the proposed modification of a device described in a relied upon reference would change the principle of operation thereof, then the disclosures of the references are not sufficient to render the claims prima facie obvious). In view of the foregoing, it is respectfully submitted that Shiratori et al. do not render unpatentable claim 3 for at least the foregoing reasons.

V. Rejection of Claim 7 Under 35 U.S.C. § 103(a)

Claim 7 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Shiratori et al. and U.S. Patent No. 4,711,463 ("Knable et al.").

Applicant respectfully submits that the combination of Shiratori et al. and Knable et al. does not render unpatentable claim for the following reasons.

Claim 7 depend from claim 1. As more fully set forth above, claim 1 has been amended herein without prejudice to recite that the at least one stop buffer is annular, and Shiratori et al. do not disclose, or even suggest, an annular stop buffer. Since Shiratori et al. describe air vent passageways 66, 68 arranged between bosses 62, 64 to permit communication between the annular grooves 52, 54 and the outside atmosphere, it is respectfully submitted that there is no motivation or suggestion to modify the device described by Shiratori et al. to include an annular stop buffer. This is because doing so would render the device described by Shiratori et al. unsatisfactory for its intended purpose and/or change the principle of operation thereof. See, In re Gordon, supra; In re Ratti, supra. Knable et al. do not cure the critical deficiencies of Shiratori. In view of the foregoing, it is respectfully submitted that the combination of Shiratori et al. and Knable et al. does not render unpatentable claim 7 for at least the foregoing reasons.

VI. New Claim 14

New claim 14 has been added herein. It is respectfully submitted that claim 14 adds no new matter and is fully supported by the present application, including the Specification. Since claim 14 includes features analogous to features included in claim 1, it is respectfully submitted that claim 14 is patentable over the references relied upon for at least the same reasons set forth above in support of the patentability of claim 1.

VII. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: May 12, 2004

By: 

Richard M. Rosati
Reg. No. 31,792
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646